

REMARKS

I. Response to Rejections under 35 U.S.C. § 112

The Examiner rejected claims 4, 10, and 15 under 35 U.S.C. § 112 first paragraph as failing to comply with the enablement requirement because since the expansion module in Figure 2 is "replaceable," it is also removable." The Examiner further rejected claims 4, 10, and 15 under 35 U.S.C. § 112 second paragraph as being indefinite because Figure 2 shows an expansion module that is not removable, but claims 4, 10, and 15 recite "the expansion module is removable," and "[t]herefore the specification does not clearly disclose a removable expansion module."

In response, Applicant would like to point out that the specification does indeed disclose a removable expansion module in Figure 1, reference number 16. Figure 2 is merely an alternate embodiment of the invention disclosing an expansion module that is not removable. Moreover, Applicant clearly discusses the meanings of the terms "removable" and "replaceable" in the specification on page 5 at lines 10-13. Accordingly, Applicant respectfully requests that the § 112 rejections be withdrawn.

II. Response to Rejections Under 35 U.S.C. §§ 102 and 103

The Examiner rejected claims 1, 6, 12, 16, and 19 under 35 U.S.C. § 102(a) as being anticipated by *Kita et al.* (U.S. Pat. App. Pub. No. 2001/004397). The Examiner further rejected claims 1-3, 5, 7-9, 11, 13, 14, 17, 18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Matsuda et al.* (U.S. Pat. No. 5,504,658) in view of *Sawada et al.* (U.S. Pat. No. 6,342,664). Applicants traverse these rejections for at least the following reasons.

Applicant's claim 1 is directed toward a portable audio device. The portable audio device includes "an expansion module operable to provide additional capacity to the digital audio player, wherein the expansion module resides on a *removable component* at a location away from the digital audio player, the removable component being communicatively coupled to the digital audio player *when the digital audio player is playing audio signals*, and wherein the expansion module includes *additional* memory that is *accessible by the digital audio player when the digital audio player is playing audio signals*." The expansion module may be located, for example, on a remote control or the audio outputs.

The additional memory in the expansion module is accessible by the digital audio player when the digital audio player is playing audio signals. For example, when the user is carrying the digital audio player around to different locations, the digital audio player can still access the additional memory in the expansion module and can play audio signals that are stored on the expansion module.

In contrast, *Kita* discloses a body-wearable type music reproducing apparatus. The Examiner equates the expansion module of the present application with the external device 800, on page 7, ¶ [0128] of *Kita*, which is a personal computer ("PC") or other such non-portable device. See e.g., Fig. 19, Fig. 21A and ¶ [0151]. The external device 800 in *Kita* is used to program music into the music reproducing device. The music reproducing device can then be disconnected from the external device 800, thereby making the music reproducing device portable for a user to carry around. Thus, the external device 800 in *Kita* is not attached to the music reproducing apparatus when the user is carrying it around and playing music. Therefore, the external device in *Kita* is not "a *removable* component being communicatively coupled to the digital audio player *when the digital audio player is playing audio signals*."

Additionally, *Kita's* music reproducing apparatus contains a single memory card 209 and battery 216, see page 5, paragraph [0102]. The memory card and battery are an integrated part of *Kita* and not part of an external module. Thus, *Kita* fails to disclose **additional** memory or battery coupled to the apparatus and available when the player is in use. Therefore, *Kita* clearly does not anticipate the present claims, and applicant respectfully requests that the § 102 rejection be withdrawn.

Figure 4 of *Matsuda* discloses a portable audio unit with a remote control and earphones. A button battery is embedded in the remote control for supplying power to the display unit on the remote control. However, the additional battery does not provide memory or even power to the portable audio unit; it merely acts as a power source to the display unit on the remote control. Thus, there is no "**additional** memory that is **accessible by the digital audio player**," located on a removable component. Therefore, *Matsuda* fails to disclose additional memory and battery for the digital audio device. *Sawada* does not remedy the deficiencies of *Matsuda* or *Kita*, and therefore the § 103 rejection is improper and should be withdrawn.

With respect to claims 5 and 11, the present application allows for the expansion module to reside on one or more audio outputs, including earphones, as described on pages 5-6, lines 21-25 and 1-16, respectively. The Examiner states that Figure 4 of *Matsuda* discloses "audio outputs which travel along the path of the remote control, therefore the expansion module resides on the audio outputs." Contrary to the Examiner's assertion, however, *Matsuda* does not contain an expansion module as an additional component of the audio outputs. The audio signal travels along the path of the remote control to the audio outputs, but there is no expansion module residing on one or more of the audio outputs. Indeed, none of the prior art references disclose or even suggest the expansion module residing on the audio outputs.

For at least the same reasons, independent claim 8, 14 and 18, along with their respective dependent claims are also allowable. In view of the foregoing, Applicant respectfully requests that all of the rejections of the pending claims be withdrawn. Applicant hereby earnestly solicits an early Notice of Allowance. If for any reason, the application is not considered to be in condition for allowance on the next Office Action and an interview would be helpful to resolve any remaining issues, the Examiner is requested to contact the undersigned attorney at (312) 913-3303.

Respectfully submitted,

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